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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,193	11/04/2003	Osamu Kurosawa	8305-234US (NP61-0002-1)	6237
570	7590	05/22/2006	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			LANG, AMY T	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/701,193	<b>Applicant(s)</b> KUROSAWA ET AL.	
	<b>Examiner</b> Amy T. Lang	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-20-2004</u> | 6) <input type="checkbox"/> Other: ____  |

Art Unit: 1714

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: page 1, lines 19-21 includes the phrase "resulting in a strong demand has been urged and resulted in a strong demand." This context is unclear and it is recommend that the sentence is rephrased. The phrase on page 20, line 27 through page 21, line 1 includes "the composition is made to from." Again, this context is unclear and it is advised to rephrase. On page 22, the word "obtain" on line 15 is incorrect in context and it is advised to replace with "obtained."

Appropriate correction is required.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. Claims 1 and 2 are objected to because of the following informalities: the temperature at which the viscosity of the mineral oil is measured is omitted in claims 1 and 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1714

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

obviousness or nonobviousness.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tersigni (US 6,482,778 B2) in view of Komiya (US 2001/0044389 A1).

Tersigni discloses a transmission fluid composition comprised of base oil and a phosphorus-containing additive (column 1, lines 8-13; column 2, lines 1-4). The base oil is disclosed as a mineral oil, including paraffinic and naphthenic mineral oils, with a kinematic viscosity of 3 to 8 centistokes at 100 degrees Celsius (column 12, lines 9-18).

Although the instant claims 1 and 2 do not include the temperature at which the kinematic viscosity was measured, it is the examiner's position that the applicant has support for a temperature of 100 degrees Celsius in view of page 5 of the specification.

Since centistokes is equivalent to  $\text{mm}^2/\text{s}$ , this viscosity range clearly overlaps the instant claims 1 and 2. Tersigni also discloses the addition of a viscosity index improver so that the kinematic viscosity of the composition is increased to at least 5.0 cSt at 100 degrees Celsius (column 12, lines 24-27). This range clearly overlaps the instant claims 1 and 2 since 5.0 cSt falls directly within the instant range of 5.0 to 6.0  $\text{mm}^2/\text{s}$ . The phosphorus

Art Unit: 1714

content is also disclosed as 0.02 to 0.08 percent by mass (column 2, lines 9-11).

Additionally, Tersigni discloses that antioxidants, including sulfurized phenolic antioxidants are typically added to the composition (column 10, lines 46-50). These antioxidants are further disclosed in the content of 0 to 1 mass percent, which clearly overlaps the instant claims 1 and 2. However, Tersigni is silent as to the % Cp of the disclosed mineral oil.

Komiya discloses a lubricating composition for transmissions comprised of mineral oil, including paraffinic and naphthenic mineral oils ([0002], 0012], [0016]). The disclosed mineral oil has a kinematic viscosity of 1 to 4 mm<sup>2</sup>/s, which clearly overlaps the instant claims 1 and 2 ([0014]). Additionally, the % Cp of the oil is disclosed as 70 or higher as defined by ASTM D 3238 ([0012]). It is the examiner's position that the transmission oils disclosed by Tersigni and Komiya both contain similar mineral oils, paraffinic and naphthenic oils at the same viscosity, and would therefore display the same characteristics. Komiya specifically uses mineral oil with a % Cp from 75 to 81 since base oil in this range of % Cp displays excellent low temperature fluidity (Table 1, page 8, {0013}). Therefore, it would have been obvious to use a base mineral oil in the range of % Cp from 75-81 in the transmission disclosed by Tersigni, because Komiya teaches enhanced low temperature fluidity would result. Therefore, one of ordinary skill would thereby obtain the invention as set forth in the presently cited claims.

Art Unit: 1714

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ATL

05/12/2006

*Vasu Jagannathan*  
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SUPERVISORY PATENT EXAMINER  
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Application/Control Number: 10/701,193  
Art Unit: 1714

Page 6